APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/608,267	06/27/2003	Brian Jones	60001.0244US01/MS300530.1	8319

27488 7590 01/25/2007		EXAMINER
MERCHANT & GOULD (MICROSOFT)		PAULA, CESAR B
P.O. BOX 2903		
MINNEAPOLIS, MN 55402-0903	ART UNIT	PAPER NUMBER
	2178	

SHORTENED STATUTORY PERIOD OF RESPONSE	MAIL DATE	DELIVERY MODE
3 MONTHS	01/25/2007	PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

If NO period for reply is specified above, the maximum statutory period will apply and will expire 6 MONTHS from the mailing date of this communication.

	Application No.	Applicant(s)
Office Action Summary	10/608,267	JONES ET AL.
	Examiner	Art Unit	
	CESAR B. PAULA	2178	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE <u>3</u> MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.
- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on <u>26 December 2006</u>.

2a)☐ This action is **FINAL**.   2b)☒ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) <u>2-5,7-19 and 21-23</u> is/are pending in the application.

    4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) <u>2-5,7-19 and 21-23</u> is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

    Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

    Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

    a)☐ All b)☐ Some * c)☐ None of:

      1.☐ Certified copies of the priority documents have been received.

      2.☐ Certified copies of the priority documents have been received in Application No. _____.

      3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

    * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☒ Notice of References Cited (PTO-892)

2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)

3) ☒ Information Disclosure Statement(s) (PTO/SB/08)
    Paper No(s)/Mail Date <u>See Continuation Sheet</u>.

4) ☐ Interview Summary (PTO-413)
    Paper No(s)/Mail Date. _____ .

5) ☐ Notice of Informal Patent Application

6) ☐ Other: _____.

Continuation of Attachment(s) 3). Information Disclosure Statement(s) (PTO/SB/08), Paper No(s)/Mail Date :10/02, 10/26, 10/30, 11/20, and 12/26/06.

DETAILED ACTION

1.   This action is responsive to the RCE amendment, and IDSs filed on 10/30, 10/02, 10/26,

10/30, 11/20, and 12/26/2006 respectively.

This action is made Non-Final.

2.   In the amendment, claim 6 has been canceled. Claims 2-5, 7-19, and 21-23 are pending in

the case. Claims 3, 11, and 21 are independent claims.

Drawings

3.   The drawings filed on 6/27/2003 have been accepted by the Examiner.

Specification

4.   The abstract of the disclosure is objected to because it contains more than 150 words.

Correction is required. See MPEP § 608.01(b).

Information Disclosure Statement

5.   The information disclosure statements filed on 10/02, 10/26, 10/30, 11/20, and

12/26/2006 have been considered.

Claim Rejections - 35 USC § 101

6.   The rejections of claims 2-10, and 21-23 rejected under 35 U.S.C. 101 have been withdrawn as necessitated by the amendment.

Claim Rejections - 35 USC § 112

7.   The following is a quotation of the first paragraph of 35 U.S.C. 112:

> The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

8.   Claims 2-10 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the enablement requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention. Claim 3 recites *wherein for any portion of the text string not annotated with markup language data the method further comprises, and receiving markup language data associated with the text string in the recognizer dynamically linked library(lines 14-15, and 17-18)*. These limitations do not appear to be found in the specification as to allow one of ordinary skill in the art to implement a text string does not have markup language data associated or annotated, while the same text string does have annotated markup language data.

9.   The following is a quotation of the second paragraph of 35 U.S.C. 112:

> The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

10.   Claims 2-10 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for

failing to particularly point out and distinctly claim the subject matter which applicant regards as

the invention. Claim 3 recites *wherein for any portion of the text string not annotated with*

markup language data the method further comprises, and receiving markup language data

associated with the text string in the recognizer dynamically linked library(lines 14-15, and

17-18) . There appears to be a contradiction in these limitations, since the first limitation

indicates that the text string does not have markup language data associated or annotated, while

the second limitation states that the text string does have annotated markup language data.

Claim Rejections - 35 USC § 102

11.   The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the

basis for the rejections under this section made in this Office action:

> A person shall be entitled to a patent unless –
>
> (a) the invention was known or used by others in this country, or patented or described in a printed publication in this or a foreign country, before the invention thereof by the applicant for a patent.

12.   Claims 2-5, 7-19, and 21-23 are rejected under 35 U.S.C. 102(a) as being anticipated by

Huynh et al, hereinafter Huynh, (USPub # 2002/0198909, 12/26/2002).

        Regarding independent claim 3, in light of the 35 USC 112 rejections above, it is

believed that Hyunh discloses an application program module for creating a document, and

communicating with action DLLs connected to the program, which determine what actions,

associated with a markup language document text strings, to present to a user in relation to the

markup language of the data strings. A recognizer DLL sends semantic categories including labels to the program module (0036, 0039-0042, 0044, 104-106).

Additionally, Hyunh discloses the storage of semantic categories containing a namespace in a document (0039, 0104-0107). --*receiving a text string annotated with markup language data in an action dynamic link library (DLL); transmitting the text string and the associated markup language data to a plurality of action plug-ins; determining, in the action plug-ins, one or more actions based on the associated markup language data; passing the one or more actions to an application program module for displaying the one or more actions in association with the text string; displaying the one or more actions in association with the text string; wherein for any portion of the text string not annotated with markup language data the method further comprises: receiving the text string in a recognizer dynamically linked library (DLL); receiving markup language data associated with the text string in the recognizer dynamically linked library; parsing the associated markup language data to assist the recognizer DLL to determine one or more labels for the text string; and transmitting the one or more labels and the associated markup language data to the application program module for passing to the action DLL.*

Regarding claim 2, which depends on claim 3, Hyunh discloses action DLLs connected to the program, which determine what actions, associated with a markup language document text strings, to present to a user in relation to the markup language of the data strings. A recognizer DLL sends semantic categories including labels to the program module (0036, 0039-0042, 0044, 104-106).

Regarding claim 4, which depends on claim 3, Hyunh discloses recognizer plugins pass

the labeling results, for every string, to the recognizer DLL, which in turn passes the obtained

results to the program (0039-0042, 0044, 104-107).

Regarding claim 5, which depends on claim 3, Hyunh discloses comparing the strings

and the markup for matching labels. If a match is found labeling the string with the associated

label (0039-0042, 0044, 104-107).

Regarding claim 7, which depends on claim 3, Hyunh discloses adding labels to the

document (0042-0044).

Regarding claim 8, which depends on claim 7, Hyunh discloses adding labels to the

document, once the label has been obtained (0042-0044).

Regarding claim 9, which depends on claim 3, Hyunh discloses adding labels to the

document, using metadata (0042-0044).

Regarding claim 10, which depends on claim 3, Hyunh discloses adding labels to an

XML document, once the label has been obtained (0042-0044, 0105-0106).

Regarding independent claim 11, Hyunh discloses an application program module for creating a document, and communicating with action DLLs connected to the program, which determine what actions, associated with a markup language document text strings, to present to a user in relation to the markup language of the data strings. A recognizer DLL sends semantic categories including labels to the program module. Metadata is used for those cases where information found in a string is not sufficient (0036, 0039-0042, 0044, 0064, 0070-0071, 104-106) -- *as a string of text having an associated one or more Extensible Markup Language (XML) elements is entered into the electronic document, determining whether the string of text matches one of a plurality of stored strings; if so, then designating a label associated with the matched stored string for application to the entered string of text; if the string of text does not match one of a plurality of stored strings, determining whether the one or more XML elements associated with the string of text is associated with a label for use with the entered string of text; and if so, then designating a label associated with the one or more XML elements for application to the entered string of text.*

Regarding claim 12, which depends on claim 11, Hyunh discloses adding actions associated with labels of the document text string or markup (0042-0044, 0104-016).

Regarding claim 13, which depends on claim 12, Hyunh discloses adding labels to the document using semantic categories containing a namespace in a document (0039, 0042-0044, 0104-0107).

Regarding claim 14, which depends on claim 11, Hyunh discloses adding actions associated with labels of the document text string or markup (0042-0044, 0104-016).

Regarding claim 15, which depends on claim 13, Hyunh discloses adding actions associated with labels of the document text string or markup (0042-0044, 0104-016).

Regarding claim 16, which depends on claim 15, Hyunh discloses adding actions associated with labels of the document text string or markup. A user is allowed to select and perform the actions (0042-0044, 0104-016).

Claim 17 is directed to a computer readable medium for performing the steps of claim 16, and therefore is similarly rejected.

Regarding claim 18, which depends on claim 16, Hyunh discloses an action DLL determining and passing action to be performed to appropriate action plugins (0040-0044).

Regarding claim 19, which depends on claim 11, Hyunh discloses using a URL if there is no action plugin associated with the label (0042-0044).

Regarding independent claim 21, Hyunh discloses an application program module for

creating a document. An action DLL connected to the program determines what actions, associated with a markup language document, to present to a user. A recognizer DLL sends semantic categories including labels to the program module (0036, 0039-0040, 0044, 104-106).

Additionally, Hyunh discloses the storage of semantic categories containing a namespace in a document (0039, 0104-0107).

Regarding claim 22, which depends on claim 21, Hyunh discloses an application program module for creating a document, and communicating with action DLLs connected to the program, which determine what actions, associated with a markup language document text strings entered by a user, to present to a user in relation to the markup language of the data strings. A recognizer DLL sends semantic categories including labels to the program module (0036, 0039-0042, 0044, 104-107).

Claim 23 is directed to a system for performing the steps of claim 4, and therefore is similarly rejected.

Response to Arguments

13.   Applicant's arguments with respect to claims have been considered but are moot in view of the new ground(s) of rejection. The Applicants are directed towards the new grounds of rejection above in light of the newly found prior art.

Conclusion

I.   The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. Khoshatefeh et al. (Pat. # 2004/0133846 A1), Brewer et al. (Pat. # 2002/0169802 A1), and Horn et al. (Pat. # 7,013,289 B2).

II.   Any inquiry concerning this communication or earlier communications from the examiner should be directed to Cesar B. Paula whose telephone number is (571) 272-4128. The examiner can normally be reached on Monday through Friday from 8:00 a.m. to 4:00 p.m. (EST).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Stephen Hong, can be reached on (571) 272-4124. However, in such a case, please allow at least one business day.

Information regarding the status of an application may be obtained from the Patent Application Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, go to http://portal.uspto.gov/external/portal/pair. Should you have any questions about access to the Private PAIR system, please contact the Electronic Business Center (EBC) at 866 217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, please call 800-786-9199 or 571 272-1000 (USA or Canada).

Any response to this Action should be mailed to:

Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450
Or faxed to:

- **(571)-273-8300 (for all** Formal communications intended for entry)

CESAR PAULA
PRIMARY EXAMINER

1/8/07